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For all the skilled artisan is informed by Parker, the disclosed system is fully automated and no human intervention is required, enabled or even possible. Certainly it cannot be maintained that Parker somehow inherently discloses the active participation of a person at the site in preparing the message for digital combination with the data file. Applicants therefore respectfully urge that the recited active participation on the part of the person to whom the message is provided is in fact a limitation that is not identically disclosed by Parker.

The PTO is heard to state that "[i]f the prior art structure is capable of performing the intended use, then it meets the claim." Applicants remind the PTO that claim 1 is directed to a method comprising steps, not to a device having any particular physical structure. Applicants have demonstrated that claim 1 includes the limitation, not disclosed either explicitly or inherently by Parker, that the person at the site to whom the message is provided prepares the message prior to its combination with the data file.

The PTO goes on to cite Parker's disclosure at paragraph 0052 pertaining to the use of a chat room in the disclosed card customization process. However, the chat room discussed by Parker is used to provide "further customization and/or suggestion *by other users*," that is, by other persons who desire to have customized cards produced. In the chat room, in other words, two or more users can discuss customization of their cards and provide each other with suggestions concerning particular expressions or other aspects of the customization procedure. The users can also contribute the suggested expressions "for inclusion in the entire expression database." Nothing in this paragraph in any way suggests the presence of a person who receives a message and then prepares it for combination with a data file to produce a personalized data file. Discussions and suggestions in chat rooms in no way constitute such a reception and preparation.

The PTO's reference to paragraph 0059 of Parker likewise does not support a Section 102(e) rejection. Applicants point out that the full teaching of Parker in paragraph 0059 states as follows: "It is possible as indicated at operation 422 to allow the *sender* to upload a particular image for their own use in creating the card. The system also includes the ability for *visitors to the website* to submit their images for inclusion in the database 430 for general use of all visitors. In certain cases, the donors may be compensated if desired. The *database of expressions and images* would include information identifying the creator-donor." (Emphasis added.) Thus, Parker's actual teaching pertains to enabling senders, i.e., card creators, to provide *their own images* for inclusion in their own cards, and also to donate images for use by other card creators. Nothing in this teaching compensates for the failure of Parker to disclose the presently recited active participation on the part of the person to whom the message is provided.

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For all of the foregoing reasons, Parker must fail as a Section 102(e) anticipatory reference with respect to claim 1 and all claims dependent thereon. It is respectfully requested that the rejection on this basis be withdrawn.

As to present claim 4, Parker nowhere discloses the use of an image of the person to whom the message is provided. Present claim 4, and claims 5-8 dependent thereon, recite that the first data file comprises at least one image of the person to whom the message is provided. The PTO argues that "The user/celebrity *can* use his/her own image or any other image including images sent to him/her in creating the personalized greeting card." If the PTO means to argue that claim 4, and claims 5-8 dependent thereon, would have been unpatentably obvious in view of Parker (which applicants deny), then applicants invite the PTO to present such an argument in the context of a Section 103(a) rejection. However, absent an inherent disclosure both of participation on the part of the person to whom the message is provided and use of a data file comprising an image of that very person, Parker cannot anticipate claim 4 or the claims dependent thereon. No such inherent disclosure is discernible in Parker, and thus the Section 102(e) rejection on this basis is untenable. Withdrawal thereof is courteously requested.

Present claims 10 and 11 recite that a script is provided to the person (claim 10) and that this script is read by the person and recorded to produce an audio file, which is subsequently combined with the first data file. Again, applicants point out that Parker nowhere disclose the production of any type of live performance. Parker utterly fails to disclose receiving a script, performing the script, recording the performance thereof and combining the recorded performance with a data file of any kind. No Section 102(e) anticipation of claims 10 and 11 is apparent in Parker. Once again, the PTO's position that "Parker system *allows* someone to send a message in any format e.g., video, audio, text etc., which can be selected by another person who creates a personalized greeting card" appears to constitute an allegation of obviousness under Section 103(a), rather than of anticipation under Section 102(e).

With respect to independent claim 13, and claims 14-16 and 19 dependent thereon, the PTO is heard to state that the claimed methods of producing a *recorded performance* are anticipated by Parker. Applicants once more must repeat that Parker fails to disclose, in any context, pertaining to any medium, whether audio, video, textual, graphical or otherwise, the presence at a site of a person to whom a script (or any other communication) is provided, or the active participation by that very person in recording a performance of that script. Parker is completely devoid of any teaching pertaining to the production of any performance, or to the recording of the production so produced. "Association" of a pre-existing audio or video file with a

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"particular expression" by no means constitutes a disclosure of the production of a *new recording* of a script newly provided to a person at a site on a network. Yet again, the PTO's insistence that "Parker system also *allows* the person . . . who creates the personalized data file to edit/review that message and then store it in the database" does not establish that Parker somehow identically discloses every limitation of the claimed methods, as required for a Section 102(e) rejection to be maintained. At most, such an argument sounds in the context of a Section 103(a) rejection for obviousness; no such rejection, however, is presently of record.

Applicants here reiterate their previous argument pertaining to claim 20. Parker fails to disclose means for providing a message to a person present at the site, or means for enabling that person to prepare the message. Parker therefore fails to anticipate claim 20.

Parker has been shown not to disclose identically each and every limitation of the present claims. Accordingly, Parker fails as a Section 102(e) anticipatory reference. Withdrawal of the rejections based thereon is earnestly solicited.

In view of the foregoing remarks, it is submitted that all present claims are in condition for allowance. Should the Examiner have any questions, he is invited to contact the undersigned at the telephone number indicated.

Respectfully submitted,

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